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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,277	07/01/2003	Marc Hacı	P 061459 303137	5785

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TOWNSEND AND TOWNSEND AND CREW, LLP  
TWO EMBARCADERO CENTER  
EIGHTH FLOOR  
SAN FRANCISCO, CA 94111-3834

EXAMINER

WALKER, ZAKIYA NICOLE

ART UNIT PAPER NUMBER

3672

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/612,277

Applicant(s)

HACI ET AL.

Examiner

Zakiya N. Walker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 55-59 is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-11, 20-26, 28-31, 41-46 and 60 is/are rejected.
- 7) ☒ Claim(s) 8, 12-19, 27, 32-40, 47-54, 61 and 62 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 4-19 and 54 are objected to because of the following informalities:

Claim 4, the claim should be amended to depend from claim 2 or 3 in order to provide basis for a "second speed."

Claim 7, line 3, the term "the selected angle" lacks antecedent basis because it does not specify which angle (first or second).

Claim 12, line 4 the term --third-- should be inserted after "a" [1<sup>st</sup> occurrence] in order to distinguish "the selected angle" from the first or second selected angle of the claim from which it depends.

Claim 15, line 3, the "tool face angle" lacks antecedent basis and should be replaced with --the third selected angle-- if the change is made to claim 12 above.

Claim 54, line 3, the term "routine" should be replaced with --said drill string-- in order to provide consistent terminology.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-7, 9-11, 20-26, 28-31, and 41-46 are rejected under 35 U.S.C. 102(e) as being anticipated by Eppink et al.

Eppink et al. discloses a method that includes, with respect to claim 1, a method of drilling a borehole, comprising: alternating between rotary drilling and sliding drilling using a steerable drilling motor while a drill bit remains in substantially continuous contact with a bottom of said bore hole, said steerable drilling motor being connected by a drill string to a surface drilling location. See column 5, lines 1-21 and figures 17-19 and 35-39. With respect to claim 20, the reference discloses a method of drilling a bore hole, comprising rotating and advancing a drill string having a steerable motor connected thereto in said bore hole, said drill string having a bit at a bottom end thereof; said bit being in contact with a bottom of said well: bore, thereby drilling in a rotary mode; after drilling in said rotary mode, stopping rotation of said drill string and continuing to advance said drill string with said bit in substantially continuous contact with said bottom, thereby drilling in a sliding mode. With respect to claim 41, the reference discloses a method of drilling a bore hole, comprising: advancing a drill string having a steerable drilling motor connected thereto in said bore hole, said steerable drilling motor having a tool face angle, said drill string having a bit at a bottom end thereof, said bit being in substantially continuous contact with a bottom of said well bore, thereby drilling in a sliding mode; and rotating said drill string and continuing to advance said drill string with said bit in substantially continuous contact

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with said bottom after drilling in said sliding mode, thereby drilling in a rotary mode. With respect to the depending claims, the reference teaches the limitations as claimed.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claim 60 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 6,802,378.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claim of the instant invention merely includes the limitation of rotating again in the first direction and increasing torque, which is taught by the parent '378 patent. It would have been considered obvious to one of ordinary skill in the art at the time the invention was made to have included the additional limitation in the parent patent in order to provide patent protection over additional features taught by the invention.

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***Allowable Subject Matter***

6. Claims 8, 12-19, 27, 32-40, 47-54, 61, and 62 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 8, 12-19, and 54 must also be corrected in accordance with the claim objections made in paragraph 1 above.

7. Claims 55-59 are allowed.

***Conclusion***

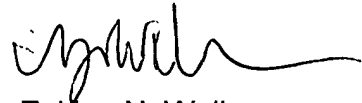
8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Chen et al. teaches a method that includes sliding and rotary drilling with a steerable motor.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zakiya N. Walker whose telephone number is (571) 272-7039. The examiner can normally be reached on Monday-Friday, 8:30 AM-5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (571) 272-6999. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Zakiya N. Walker  
Primary Examiner  
Art Unit 3672

ZW  
April 5, 2005